



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,157	12/21/2000	Makoto Nakatsu	43890-471	5545

7590 01/20/2004

McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
----------	--------------

2645

14

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,157

Applicant(s)

NAKATSU, MAKOTO

Examiner

Md S Elahee

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 10/17/03. Claims 1-15 are pending.

Response to Arguments

2. Applicant's arguments filed 10/17/03 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claim 1 has been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okawa et al. (JP Patent No. 61-294961) and in view of Tachell et al. (U.S. Patent No. 6,160,877).

Regarding claims 1 and 10, Okawa discloses a voice storage device for storing analog voice (fig.2; page no. 3, 3rd paragraph; 'voice' reads on the claim 'audio', 'device' reads on the claim 'unit' and 'analog voice' reads on the claim 'audio data').

However, Okawa fails to teach "the audio information including a response message individually pre-recorded for each of a plurality of predetermined callers, each of the callers being identified by caller information thereof". Tachell teaches the voice mail greetings (i.e., audio information including a response message) individually pre-recorded for each of a plurality

Art Unit: 2645

of predetermined callers, each of the callers being identified by calling party's identification (i.e., caller information thereof) (col. 4, lines 56-60, col.10, line 63-col.11, line 4). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okawa to allow the audio information including a response message individually pre-recorded for each of a plurality of predetermined callers, each of the callers being identified by caller information thereof as taught by Tachell. The motivation for the modification is to have doing so in order to play personal greeting according to the caller identification.

Okawa further discloses main controller for reading out the voice data stored in the voice storage device (Constitution; fig.2; page no. 3, 3rd paragraph; 'main controller' reads on the claim 'audio data controller', 'voice data' reads on the claim 'audio data' and 'voice storage device' reads on the claim 'audio storage unit').

Okawa further discloses main controller for controlling the voice storage device (fig.2; page no. 3, 3rd paragraph; 'main controller' reads on the claim 'central controller' and 'voice storage device' reads on the claim 'audio storage unit').

Okawa further discloses network control section for connecting the voice storage device to a network including a telephone frame (Constitution; fig.1, fig.2; page no. 3, 2nd paragraph, 3rd paragraph; 'network control section' reads on the claim 'network interface', 'voice data' reads on the claim 'audio data', 'voice storage device' reads on the claim 'audio storage apparatus' and 'telephone frame' reads on the claim 'telephone line and an extension line').

Okawa further discloses stored voice data is reproduced (Constitution; page no. 4, 1st paragraph; 'stored voice data' reads on the claim 'audio information corresponding to the caller information').

Art Unit: 2645

Okawa fails to teach "a caller information detector for detecting caller information from an input signal incoming from the network". Tachell teaches a visual message indicator (i.e., caller information detector) for detecting caller information from an input signal incoming from the network (col. 11, lines 7-19). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okawa to allow a caller information detector for detecting caller information as taught by Tachell. The motivation for the modification is to have caller information detector for detecting calling party's name, telephone number etc.

Okawa further fails to teach "the central controller reproduces the response message for a call which the caller information detector detects to be from at least one of the predetermined callers". Tachell teaches that the data processor/controller (i.e., central controller) reproduces the response message for a call which the visual message indicator (i.e., caller information detector) detects to be from at least one of the predetermined callers (col. 11, lines 7-19, col.12, lines 15-43). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okawa to allow the central controller reproducing the response message for a call which the caller information detector detects to be from at least one of the predetermined callers as taught by Tachell. The motivation for the modification is to have doing so in order to provide the subscriber the suitable response messages.

Regarding claims 2 and 11, Okawa further discloses main controller reproducing the stored voice data through the communication unit (fig.2; page no. 3, 3rd paragraph; 'main controller' reads on the claim 'central controller', 'stored voice data' reads on the claim 'audio information corresponding to the caller information' and 'communication unit' reads on the claim 'audio data controller').

However, Okawa fails to teach reproducing the audio information when it is judged there is a request for hearing of audio information on the basis of the input signal. Tachell teaches reproducing message (i.e., audio information) to hear the stored message (i.e., when it is judged there is a request for hearing of audio information on the basis of the input signal) (col.14, lines 36-48). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okawa to allow a reproduction of the audio information when there is a request for hearing it as taught by Tachell. The motivation for the modification is to have the request in order to get the information about the caller from the storage device.

Regarding claims 3 and 12 are rejected for the same reasons as discussed above with respect to claim 2. Furthermore, Okawa fails to teach “a group control table registering plural telephone numbers in one group”. Tachell teaches contact database (i.e., group control table) editing telephone numbers in one group (col.16, lines 16-39; ‘editing’ reads on the claim ‘registering’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okawa to allow a group control table registering plural telephone numbers as taught by Tachell. The motivation for the modification is to have the group control table in order to provide telephone numbers for different attributes.

Okawa further discloses main controller when transmitting data to in the network control section and receive data from the telephone network, reproducing the stored voice data through the communication unit (fig.2; page no. 3, 3rd paragraph; ‘main controller’ reads on the claim ‘central controller’, ‘network control section’ reads on the claim ‘network interface’, ‘telephone network’ reads on the claim ‘network’, ‘stored voice data’ reads on the claim ‘audio information

Art Unit: 2645

corresponding to the caller information' and 'communication unit' reads on the claim 'audio data controller').

However, Okawa further fails to teach "reproduces the main guidance". Tachell teaches reproducing the call screening options (i.e., main guidance) (col.12, lines 9-14). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okawa to allow a main guidance as taught by Tachell. The motivation for the modification is to have the main guidance in order to instruct the user.

Regarding claims 4 and 13 are rejected for the same reasons as discussed above with respect to claims 1-3.

Regarding claims 5 and 14 are rejected for the same reasons as discussed above with respect to claims 1-3.

Regarding claims 6 and 15 are rejected for the same reasons as discussed above with respect to claims 1-3.

Regarding claims 7 and 8 are rejected for the same reasons as discussed above with respect to claims 1-3.

Regarding claim 9, Okawa further discloses reproducing the stored voice data without an assignment of a mailbox (fig.2; page no. 3, 3rd paragraph; 'stored voice data' reads on the claim 'designated response message').

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matthews et al. (U.S. Patent 4,652,700) teach electronic audio communications system with versatile user accessibility.

Art Unit: 2645

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

M. E.
MD SHAFIUL ALAM ELAHEE
January 11, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

